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12-22-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

SPORTS MACHINE, INC.,
d/b/a Bike Source

Opposer

v.

MIDWEST MERCHANDISING INC.,

Applicant

Opposition No. 122,948

Application No. 76/035,008

**OPPOSER'S REQUEST FOR RECONSIDERATION OF THE
BOARD'S FINAL DECISION**

Opposer, Sports Machine, Inc., by its attorney, under 37 C.F.R. § 2.129(c), hereby moves the Trademark Trial and Appeal Board to reconsider its decision of November 20, 2003, in which the Board granted Applicant's "motion for summary judgment" and dismissed Opposer's opposition with prejudice.

A Memorandum Brief, as required by 37 C.F.R. §2.127(c), is attached.

Respectfully Submitted,

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Date: December 19, 2003



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**MEMORANDUM IN SUPPORT OF OPPOSER'S REQUEST FOR
RECONSIDERATION OF THE BOARD'S FINAL DECISION**

As the Board knows, Opposer in the present proceeding was Petitioner in Cancellation No. 30,578, which involved Applicant's registered mark, BIKESOURCE (in stylized form). While that case was still pending, Opposer moved to consolidate that proceeding with the present opposition proceeding. When the Board denied that motion, Opposer presumed that the issues decided in the cancellation proceeding would only concern the BIKESOURCE mark in stylized form, and that the issues concerning the later-filed application for the BIKESOURCE word mark would be adjudicated in the present proceeding. As a result of the Board's summary dismissal of the opposition, Opposer's interests and rights have been seriously impaired.

Applicant's registration for BIKESOURCE (stylized) gave it the right to use the mark only in that form. The special form in which the mark appears is itself distinctive and can change the overall commercial impression of a mark. TMEP §807.07(b)

The point is almost too obvious to state, but Applicant apparently knew of the limitations of its rights, because, prior to receiving the Petition for Cancellation (related to the previous proceeding), it felt the need to file a separate application for the BIKESOURCE mark, with a typed drawing. Registration of the word mark will give Applicant the right to use the mark in any special form or lettering. 37 C.F.R. §2.52(a)(1).

Opposer thereafter exercised his right under 15 U.S.C. § 1063(a) to oppose registration of the word mark BIKESOURCE. The Board's decision to dismiss its opposition, with prejudice, has denied Opposer his right to proceed with the opposition and requires appropriate correction.

The Board's decision does not follow from the relief originally requested by the Applicant. Applicant moved to resume the proceedings and enter judgment under TBMP §510.02(b), which permits a party to ask that judgment be entered in its behalf on one or more issues decided in another proceeding. Applicant never moved for summary judgment under TBMP §528.01. Nevertheless, the Board has chosen to treat Applicant's § 510.02(b) motion as a motion for summary judgment, on an issue that had not been pleaded, faulted Opposer for not objecting to the motion on the grounds that it was based on an unpleaded issue, deemed Applicant's answer to have been amended by agreement of the parties to allege an affirmative defense of res judicata, then applied the doctrine of res judicata to this proceeding, then proceeded to grant Applicant's "motion for summary judgment" (which had never been properly made or opposed!) on the affirmative defense of res judicata (which had never been properly pleaded!), and then dismissed the opposition with prejudice.

Generally, a motion for summary judgment requires a party to demonstrate the

absence of any genuine issue of material fact, and that it is entitled to judgment as a matter of law. TBMP §528.01. The non-moving party, which is entitled to present countering evidence, is entitled to be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist.

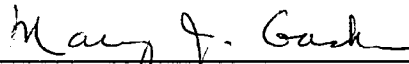
In its decision, the Board apparently based its decision entirely on the record in the cancellation proceeding, since the record in the present opposition consists only of the original pleadings and the motion to consolidate. The Board has done so without giving Opposer an informed opportunity to make its case with respect to registration of the word mark BIKESOURCE, which would confer broader rights than the BIKESOURCE (stylized) registration.

Although never explicitly stated, it is quite possible that the Board views the commercial impression and the "distinctiveness" of the BIKESOURCE mark to reside in the fact that the two generic words are represented as one word to form a unitary mark. However, should Applicant file yet another application to register the word mark BIKE SOURCE (as separate words), it would have a greater chance of success in securing the registration due to its ownership of the BIKESOURCE (stylized) and the BIKESOURCE word mark. Applicant could then attempt to prevent others from using the words BIKE SOURCE as all or part of their retail store names.

WHEREFORE, Opposer requests that the Board reconsider its decision of November 20, 2003, in which the Board dismissed this opposition, and that the Board set aside its order and reinstate the opposition proceeding, thereby allowing the Opposer to present its case.

Respectfully Submitted,

SPORTS MACHINE, INC., d/b/a Bike Source,
by its attorney




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CERTIFICATE UNDER 37 CFR 1.8

The undersigned hereby certifies that this motion is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: BOX TTAB - NO FEE, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513 on December 19, 2003.


Mary J. Gaskin

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Opposer's Request for Reconsideration of the Board's Final Decision was served on counsel for Applicant, this 19 day of December, 2003, by mailing a true copy thereof via First Class U.S. Mail, postage prepaid, addressed to Roger A. Gilcrest, Standley & Gilcrest, L.L.P., Attorney for Registrant, 495 Metro Place South, Suite 210, Dublin, Ohio 43017-5319.


Mary J. Gaskin

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